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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/524,473      | 10/28/2005  | Wolfram Schindler    | WAS0687PUSA         | 6921             |

22045 7590 12/13/2006

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| EXAMINER |
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NILAND, PATRICK DENNIS

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1714

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/524,473

Applicant(s)

SCHINDLER ET AL.

Examiner

Patrick D. Niland

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 6/15/06 & 9/22/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21,22,29,30 and 32-34 is/are allowed.
- 6) ☒ Claim(s) 15-20,24-28 and 31 is/are rejected.
- 7) ☒ Claim(s) 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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1. The amendment of 9/22/06 has been entered. Claims 15-34 are pending.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 15-20, 24-28, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 3676478 Golitz et al. with US Pat. No. 5118290 Muller et al. being cited as evidence.

Golitz discloses and claims a polymer containing terminal alkoxysilane functional groups attached via a methylene group attached to a urea group in which the N attached to the methylene group may be substituted with an aryl group, which falls within the scope of the instantly claimed group A. The applicant attributes the instantly claimed skin formation times to these functional groups and the presence or not of catalyst. The patentee is silent as to skin formation times. It is expected that where the claimed component of the patentee has the instantly claimed group A attaching the methylenealkoxysilane group to the polymer and no catalyst it will inherently have the instantly claimed skin forming time of claimed requirement a. If catalyst were added, and it is not required by all of the above claims, some catalyst in some amount within the scope of the instant claims would have been expected to give the shorter skin forming time of claimed requirement b as evidenced by the teaching of Muller et al. that

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catalysts accelerate crosslinking at column 4, lines 13-19. The skilled artisan understands that a main function of catalyst is to accelerate the reaction rate. There is no evidence commensurate in scope with the instant claims and the cited prior art that the polymers per se, containing the claimed terminal alkoxysilane groups attached with the instantly claimed functional groups, of the patentee do not have the instantly claimed skin formation times in the absence of catalyst and the presence of catalyst. This intermediate polymer does not contain the components excluded by the instant claims 16-17, 19, 20, and 31. The catalysts of claims 24-26 are not required in the claimed composition, but must merely be used in the claimed tests. Thus, it remains unseen that the compounds of claims 24-26 do not give the instantly claimed skin formation times in the polymer of the patentee discussed above. The traces of unreacted aminosilane argued by the applicant at page 11, first full paragraph of their response are bases within the scope of the instant claim 27. The method of placing them in the above discussed composition of the patentee falls within the scope of the method of the instant claim 27. The method of use implied by column 1, lines 70-71 of the patentee fall within the scope of the composition of the instant claim 28.

5. Claim 23 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not disclose the polymer which would result from this claim nor provide suggestion to make it.


6. Claims 21-22, 29-30, and 32-34 are allowable over the prior art considered. The prior art considered does not teach the use of the instantly claimed catalysts in the instantly claimed compositions nor that they would give the instantly claimed skinning rates.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Patrick D. Niland  
Primary Examiner  
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